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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/205,056 12/03/98 DATH

J F-722

EXAMINER

025264  
FINA TECHNOLOGY INC  
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HOUSTON TX 77267-4412

IM22/0213

VILDIRIM, B

ART UNIT

PAPER NUMBER

1764  
DATE MAILED:

02/13/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/205,056

Applicant(s)  
Dath et al.

Examiner  
Bekir L. Yildirim

Group Art Unit  
1764

☒ Responsive to communication(s) filed on Nov 13, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-9 and 11-14 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-9, 11-14 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. *Claims 1-9, 11-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Colombo et al. (EP0109060).*

The reference teaches the claimed catalyst and the process steps. While the propylene yield ranges are not identical, they substantially overlap (see tables 2-4) *those in the claims*.

### *Claim Rejections - 35 USC § 103*

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-9, 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colombo et al. (EP0109060).

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The reference teaches a process for producing propylene from an olefinic feed, by contacting the feed with a high silica content catalyst, e.g. silicalite, ZSM-5, SZM-11, silicalite or the like under similar conditions with those in the instant process (see tables and claims, *supra*, in both ).

It may be argued that the teachings in the references differ from the instant claims in that the teachings in the references do not specifically disclose the claimed propylene yield based on the olefin content of the feed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to manipulate the propylene content by adjusting the reaction parameters within the broader ranges since the reference process also aims to increase the propylene production and provides general guidelines in obtaining such result since the references and the applicant have the same technical endeavor, i.e. the maximizing the propylene yield. See In re Swain et al., 32 CCPA (Patents) 1250, 69 App. D.C. 217, 99 F.2d 986, 38 USPQ 213; Allen et al. v. Coe, 77 App. D.C. 324, 135 F.2d 11, 57 USPQ 136. In re Antoine, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). Furthermore even if it is assumed *arguendo* that the technical endeavors are different, i.e. the references are not concerned with maximizing propylene yield, all the process steps and the catalysts are taught in both references, thus the claimed result, i.e. the high yield, would flow naturally by the performance of the steps. "The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985)".

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reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

*Response to Arguments*

5. Applicant's arguments filed on 11/13/00 are have been fully considered and found persuasive only with respect to the first EP reference, the rejection based on which is hereby withdrawn.

With respect to the EP060 reference, the arguments are not persuasive for essentially the arguments the applicant presents in support of the E059 reference. The applicant is correct in arguing that EP059 would differ from the claims in that the si/Al ratio would be less than 180. With the same token, as calculated by the applicant the si/al ratio of the MFI catalysts of EP060 would correspond to greater than 175, which would substantially overlap those in the claims, i.e. 180 to 1000. The examples the applicant cites in support of the arguments are of silicalite in which aluminum is considered impurity (see the USP 4,061,724) which was incorporated by reference. The reference further relies on an Italian patent application for high silica ZSM-5 catalysts. Therefore the reference taken as a whole cannot be said to exclude those with silicon/aluminum ratio of a large range, i.e. 180/1000. The fact that the instant catalysts would include silicalite, by definition very high si/al ratio, and ZSM-5 which would be expected to have some alumina would argue against the contention that the instant catalyst ratios would be patentably distinct and unobvious from the reference. Furthermore, the reference teachings cannot

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be considered limited to preferred or exemplified embodiments. See also *In re Boe*, 355 F.2d 961, 148 USPQ 507 (CCPA 1966). Examiner fails to see notable differences in the reaction expedients, even if such is observed minor variations in reaction conditions based on the selected catalyst, the feed and process objectives would be expected and the determination of workable conditions would be well within the ordinary skill in the art.

The previous office action was not a final action, the inadvertent error in inclusion of a paragraph to indicate such is regretted.

#### *Conclusion*

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bekir L. Yildirim whose telephone number is (703) 308-3586. The examiner can normally be reached on weekdays from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marian Knode, can be reached on (703) 308-4311. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-6078.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0611.

B.L.Y.  
February 12, 2001



Bekir L. Yildirim  
Primary Examiner